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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO.
10/613,174	07/03/2003	Thurman R. Reed	DP-309832	9132
7590 11/14/2003				
STEFAN V. CHMIELEWSKI DELPHI TECHNOLOGIES, INC. Legal Staff MC CT10C P.O. Box 9005 Kokomo, IN 46904-9005				
EXAMINER LEE, JINHEE J				
ART UNIT 2831		PAPER NUMBER		

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/613,174	REED, THURMAN R.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jinhee J Lee	2831	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 15-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other, _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to an electronic package, classified in class 174, subclass 100.
  - II. Claims 15-23, drawn to an assembly method, classified in class 29, subclass 592.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product does not require threaded grooves.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Stefan Chmielewski on 10/30/03 a provisional election was made without traverse to prosecute the invention of group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-23 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the first member" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 6-10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by May et al. (4568899).

Re claim 1, May et al. discloses an electronic package comprising:

a housing (34 and 40 for example);

electronic circuitry located within the housing (circuit board 48 and terminals 1B-6B for example);

a first member (cover 40 for example);

a second member (base 34 for example);

a hole (unnumbered) formed in at least one of the first and second members;

a fastener screw (22 and 24 for example) engaging the hole to fasten the first member to the second member (see column 3 lines 63-64); and

a particle containment pad (unnumbered area around the hole for example) disposed adjacent to the hole (see figures 2, 4 and 5). In regards to "for collecting any particles formed during engagement of the fastener screw within the hole", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 2, May et al. discloses an electronic package, wherein the first and second members comprise first and second housing members (see figures 2, 4 and 5).

Re claim 3, May et al. discloses an electronic package, wherein the hole is non-threaded and the fastener screw is a self-threading screw, wherein the self-threading screw forms a threaded hole (see column 3 lines 63-64 and 66-67).

Re claim 6, May et al. discloses an electronic package, wherein the particle containment pad is adhered to a surface (top edge and angled surface for example, see figures 2, 4 and 5).

Re claim 7, May et al. discloses an electronic package, wherein the hole is formed in a bracket (see figures 2, 4 and 5).

Re claim 8, May et al. discloses an electronic package further comprising a printed circuit board (48 for example) located within the housing, wherein the electronic circuitry is provided on the printed circuit board (see figures 2, 4 and 5).

Re claim 9, May et al. discloses an electronic package comprising:

a first housing member (cover 40 for example);

a second housing member (base 34 for example) engaged with the first housing member to form a housing;

a hole (unnumbered) formed in at least one of the first and second housing members;

a fastener screw (22 and 24 for example) engaging the hole to fixedly engage the first housing member to the second housing member (see column 3 lines 63-64);  
and

a particle containment pad (unnumbered area around the hole for example) disposed adjacent to the hole (see figures 2, 4 and 5). In regards to "for collecting any particles formed during engagement of the fastener screw within the hole", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 10, May et al. discloses an electronic package, wherein the fastener screw is a self-threading screw that forms a threaded hole (see column 3 lines 63-64 and 66-67).

Re claim 12, May et al. discloses an electronic package, wherein the particle containment pad is adhered to a surface (top edge and angled surface for example, see figures 2, 4 and 5).

Re claim 13, May et al. discloses an electronic package further comprising a printed circuit board (48 for example) located within the housing, wherein the electronic circuitry is provided on the printed circuit board (see figures 2, 4 and 5).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 5, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over May et al.

Re claim 4, May et al. substantially discloses an electronic package as set forth in claim 1 above. May et al. does not explicitly disclose that the particle containment pad is polymeric. The examiner takes Official Notice that polymer is well known in the electrical arts for use as a padding material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a polymeric pad, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Re claim 5, May et al. substantially discloses an electronic package as set forth in claim 4 above. May et al. does not explicitly disclose that the polymeric pad comprises rubber. The examiner takes Official Notice that rubber is well known in the electrical arts as a polymeric material. It would have been obvious to one having

ordinary skill in the art at the time the invention was made to use a polymeric pad that comprises rubber, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Re claim 11, May et al. substantially discloses an electronic package as set forth in claim 9 above. May et al. does not explicitly disclose that the particle containment pad is polymeric. The examiner takes Official Notice that polymer is well known in the electrical arts for as a padding material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a polymeric pad, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Re claim 14, May et al. substantially discloses an electronic package as set forth in claim 9 above. May et al. does not explicitly disclose that the housing members comprise a metal case and cover. The examiner takes Official Notice that metal is well known in the electrical arts for use as a housing material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a metallic housing, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.



***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bienick et al. is cited to show various components of a protector.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee Lee whose telephone number is 703-306-0154. The examiner can normally be reached on M, T, Th, F at 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A Reichard can be reached on 703-308-3682. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

jil  
October 30, 2003

  
DEAN A. REICHARD  
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